

CUSTOMER NO. 46850

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re: Attorney Docket No. Basavanhally 31-3

In re application of: Nagesh R. Basavanhally and Hong Tang

Serial No.: 10/602,476

Group Art Unit: 2883

Filed: 06/24/2003

Examiner: Chiem, Dinh D.

Matter No.: 990.0487

Phone No.: 571-272-3102

For: Fiber-Optic Gauge Having One or More Side-Mounted Sensors

PETITION TO THE DIRECTOR TO REVIEW
REQUIREMENT OF RESTRICTION UNDER 37 CFR 1.144

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Petition is filed in response to the office action of 07/03/2007.

REMARKS

Procedural Posture:

In the office action of 10/05/2005, the Examiner issued a restriction requirement for claims 1-20.

In the response of 11/07/2005, the Applicants requested reconsideration of the restriction requirement and provisionally elected claims 1-3, 9, 10, 17-19, and 20 with traverse. The Applicants further requested that claims 4-5, 7-8, and 11-13 be added to the provisional election.

In the office action of 02/15/2006, the Examiner examined claims 1-3, 9, 11-12, and 17-20 on the merits and withdrew claims 4-8, 10, and 13-16 from consideration.

In the response of 06/29/2006, the Applicants added new claims 21-23 and argued for the allowability of all pending claims.

In the office action of 08/24/2006, the Examiner found the Applicants' arguments persuasive, **withdrew the restriction requirement**, and examined claims 1-23 on the merits. The Examiner objected to claims 4-8 and 13-16 as being dependent upon a rejected base claim, but indicated that those claims would be allowable if rewritten in independent form.

In the response of 11/20/2006, the Applicants canceled claim 2 and added new claims 24-28. Of the new claims, claims 25, 27, and 28 were equivalent to original claims 13, 15, and 16, respectively, rewritten in independent form, and claim 26, which depended from claim 25, was equivalent to original claim 14.

In the office action of 07/03/2007, the Examiner reinstated the restriction requirement and withdrew claims 4-8, 13-15, and 25-28 from consideration.

Applicants' attorney Yuri Gruzdkov attempted to reach the Examiner to discuss the reinstatement of the restriction requirement. However, his attempts were unsuccessful. Yuri Gruzdkov's voice mails regarding this matter left on 09/17/2007 and 09/20/2007, respectively, for Examiner Erin Chiem (571-272-3102) were not returned. Yuri Gruzdkov's voice mail regarding the same left on 09/25/2007 for Supervisory Examiner Frank Font (571-272-2415) was not returned either.

Not a Serious Burden on the Examiner:

According to MPEP § 803, for a restriction requirement to be proper, there must be a serious burden on the Examiner to consider all claims together. The Applicants submit that reinstatement of the restriction requirement is improper because claims 4-8, 13-15, and 25-28 had **already** been **examined on the merits** by the Examiner and, therefore, there would be no serious burden on the Examiner if these claims remained under consideration. Thus, it is submitted that reinstating the restriction requirement is not appropriate nor permissible.

Additional Considerations:

In reliance on the previous withdrawal of the restriction requirement and indication of claim allowability (see office action of 08/24/2006), the Applicants had incurred an extra-claim fee of \$1,000.00. This detrimental reliance provides an additional reason against the reinstatement of the restriction requirement.

In view of the above remarks, the Applicant believes that the entire application is in proper condition for being examined on the merits, and early and favorable action is respectfully solicited.

During the pendency of this application, the Commissioner for Patents is hereby authorized to charge payment of any filing fees for presentation of extra claims under 37 CFR

1.16 and any patent application processing fees under 37 CFR 1.17 or credit any overpayment to Mendelsohn & Associates, P.C. **Deposit Account No. 50-0782.**

The Commissioner for Patents is hereby authorized to treat any concurrent or future reply, requiring a petition for extension of time under 37 CFR § 1.136 for its timely submission, as incorporating a petition for extension of time for the appropriate length of time if not submitted with the reply.

Respectfully submitted,

Date: 10/03/2007
Customer No. 46850
Mendelsohn & Associates, P.C.
1500 John F. Kennedy Blvd., Suite 405
Philadelphia, Pennsylvania 19102

/Yuri Gruzdkov/
Yuri Gruzdkov
Registration No. 50,762
Attorney for Applicant
(215) 557-8544 (phone)
(215) 557-8477 (fax)